

REMARKS

Claims 1-18 are originally pending. No claims have been amended, canceled, or added. In view of the following remarks, withdrawal of the outstanding rejections to the pending claims is respectfully requested.

35 USC §102 Rejections

Claims 1-6 and 13-18 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,867,164 to Bornstein et al. ("Bornstein"). These rejections are traversed.

It is a fundamental principal of patent law that to anticipate a claim, a single reference must teach each and every element of the claim as set forth in the claim. (MPEP §2131).

Claim 1 recites "constructing a sentence-based summary of a document's writings, and "inserting the sentence-based summary at a beginning of the document". In addressing these features, the Action concludes that Bornstein's description at col. 2, lines 53-64, for displaying a "top sentence" in a user interface window anticipates the features of "inserting the sentence-based summary at a beginning of the document", as recited by claim 1. This conclusion is unsupportable.

Bornstein describes a document summarization system that *extracts material from a document* and displays that extracted material into a window on a computer display device—the window is not the document from which the material was extracted. Let's take a look at col. 2, lines 53-64 of Bornstein, the portion cited by the Action:

1 *"FIG. 6 is a sample user interface display showing some or*
2 *all of the "top sentence" of each document in a display line or*
3 *listing of documents in a computer system user interface;*

4 *FIG. 7 is a sample user interface display showing the "top*
5 *sentence" of a document in a comments field of an*
6 *informational window of the document in a computer system*
7 *user interface;*

8 *FIG. 8 is a sample user interface display showing the "top*
9 *sentence" of a document in a pop-up area of a display line or*
10 *listing of documents in a computer system user interface".*

11 These cited portions of Bornstein describe displaying a top sentence of a
12 document into a "listing of documents", "comments field", or "a pop-up
13 area of a display line" in a user interface window. Referring to Fig. 6, it is
14 respectfully submitted, although likely that the "listing of documents"
15 names the document from which the top sentence was extracted, the top
16 sentence was not extracted from the "listing of documents", but rather a
17 document named in the listing of documents. This exclusionary
18 differentiation between user interface elements which present a top
19 sentence and the document from which the top sentence was extracted for
20 presentation in the user interface, also applies to Figs. 7 and 8. Explicit
21 description of Bornstein, at col. 8, lines 33-56, supports this by describing
22 that "top sentence" represents "a sentence of a document that is most
23 indicative of the contents of the document". Thus, Bornstein does not use
24 the term "top" in the phrase "top sentence" to indicate a physical
25 positioning of the sentence in the document from which the sentence was

1 derived, but rather to identify a sentence that is indicative of document
2 contents.

3 For instance, Bornstein at col. 8, lines 37, describes:

4 *"[a]nother useful application of the present invention is*
5 *within the user interface of a modern computer system, such*
6 *as the Apple Macintosh Finder, where stored documents*
7 *(either locally stored, e.g., on a hard disk drive of the*
8 *computer, or remotely stored, e.g., across a network or even*
9 *across the internet) can be displayed by name, application*
10 *type, date created, etc. When using such an interface, a user*
11 *is oftentimes faced with a window displaying a long list of*
12 *such stored documents without much hint as to what the*
13 *documents actually contain. While documents or files are*
14 *often given a particular name in order to provide a hint of*
15 *their content or subject matter, the user is still often left*
16 *wondering what a particular document or documents contain.*
17 *As such, using the summarization engine of the present*
18 *invention, the system could provide a "show top sentence"*
19 *option. This option would display to the user the one sentence*
20 *of a document which is most indicative of the contents of that*
21 *document."*

22 Clearly, Bornstein is describing a document summarization system that
23 extracts material from a document and displays that extracted material into
24 a window on a computer display device, wherein the window is not the
25 document from which the material was extracted.

In accordance with these teachings of Bornstein, the cited portion of
Bornstein and the illustrations of Figs. 6-8 do not respectively describe or
show that the top sentence is presented in the window at the beginning of
the document from which the top sentence was derived. Instead, these
explicit descriptions and illustrations of Bornstein show that the "top

1 sentence" is displayed in a window with respect to a "listing of
2 documents", "comments field", or "a pop-up area of a display line".

3 In view of the above, nowhere does Bornstein describe "constructing
4 a sentence-based summary of a document's writings, and "inserting the
5 sentence-based summary at a beginning of the document", as claim 1
6 recites. For this reason alone, Bornstein does not teach each and every
7 element of claim 1 as set forth in the claim.

8 Accordingly, the 35 USC §102(e) rejection of claim 1 as anticipated
9 by Bornstein is improper and should be withdrawn.

10 Claims 2-6 depend from claim 1 and are allowable over Bornstein
11 solely by virtue of this dependency.

12 Accordingly, the 35 USC §102(e) rejections of claims 2-6 are
13 improper and should be withdrawn.

14 Claim 13 recites "constructing a textual content-based summary of a
15 document's writings", and "inserting the textual content-based summary at
16 a beginning of the document and on a common page with starting content
17 of the document". For the reasons already discussed above with respect to
18 claim 1, Bornstein does not anticipate these features of claim 13.

19 Accordingly, the 35 USC §102(e) rejection of claim 13 is improper
20 and should be withdrawn.

21 Claims 14-18 depend from claim 13 and are allowable over
22 Bornstein solely by virtue of this dependency.

23 Accordingly, the 35 USC §102(e) rejection of claims 14-18 is
24 improper and should be withdrawn.

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1 **35 USC §103 Rejections**

2 Claims 7-12 stand rejected under 35 USC §103(a) as being
3 unpatentable over Bornstein in view of Stark et al., "The Working Word",
4 PC Magazine, p. 487, Oct. 16, 1990 (hereinafter referred to as "Stark").
5 These rejections are traversed.

6 **Claim 7** recites "evaluating words in the document to identify
7 ordered sets of words that appear repeatedly in a same order", "ranking
8 individual sentences in the document by treating the ordered sets of words
9 as if they were single words", and "generating the summary based at least
10 in part on the sentence rankings." Bornstein in view of Stark does not
11 teach or suggest these claimed features for the following reasons.

12 A fundamental aspect of patent law stated by the MPEP §2143 is
13 that "there must be some suggestion or motivation, either in the references
14 themselves or in the knowledge generally available to one of ordinary skill
15 in the art, to modify the reference or to combine reference teachings." This
16 means that prior art patents are references only for what they clearly
17 disclose or suggest. It is not proper to use a patent as a reference to modify
18 its structure to one which prior art references do not suggest. In other
19 words, modification unwarranted by the disclosure of a reference is
20 unwarranted.

21 In addressing claim 7, the Action points to Bornstein's teaching of
22 "determining the significance of particular words and/or sentences, usually
23 by focusing on position in the document, semantic relationships, and term
24 frequencies" to conclude that Bornstein teaches "identify ordered sets of
25

1 words that appear repeatedly in a same order", as claim 7 recites. This
2 conclusion is unsupportable.

3 Bornstein's teaching that word significance is a function of
4 document positions, semantic relationships, and term frequencies does not
5 teach or suggest "identify ordered sets of words that appear repeatedly in a
6 same order", as claim 7 recites. This is especially the case since Bornstein,
7 with the exception of teaching that a "window instantaneously updates to
8 display a summary with more or less detail and *in the same order* as the
9 original document", is completely silent with respect to "the same order" of
10 anything else. As such, the broad teaching that word significance is a
11 function of document positions, semantic relationships, and term
12 frequencies does not warrant modification by the Action to arrive at the
13 claimed "evaluating words in the document to identify ordered sets of
14 words that appear repeatedly in a same order".

15 The Action does not rely on Stark for "evaluating words in the
16 document to identify ordered sets of words that appear repeatedly in a same
17 order", as claim 7 recites.

18 In view of the above, a prima facie case of obviousness of claim 7
19 over Bornstein in view of Stark has not been presented. For this reason
20 alone, the 35 USC §103(a) rejection of claim 7 over Bornstein in view of
21 Stark is improper and should be withdrawn.

22 Additionally, and since the Action's modification to Bornstein is not
23 supported in the Action by way of prior art citation, official notice, stated
24 scientific theory, basis for common knowledge in the art, or cited legal
25 precedent, it is respectfully submitted that this modification to Bornstein is

1 either being made with impermissible hindsight reconstruction of the
2 features of claim 7, or that the Office is using personal knowledge.

3 “When a rejection in an application is based on facts within the
4 personal knowledge of an employee of the office, the data shall be as
5 specific as possible, and the reference must be supported, when called for
6 by the applicant, by the affidavit of such employee, and such affidavit shall
7 be subject to contradiction or explanation by the affidavits of the applicant
8 and other persons.” 37 CFR §1.104(d)(2). If this modification to Bornstein
9 is being made based on personal knowledge of the Examiner, the Examiner
10 is respectfully requested to supply such an affidavit to support this
11 modification to Bornstein that is not otherwise supported by prior art
12 citation, official notice, stated scientific theory, basis for common
13 knowledge in the art, or cited legal precedent.

14 Moreover, in addressing claim 7, the Action admits that Bornstein
15 does not teach or suggest “ranking individual sentences in the document by
16 treating the ordered sets of words as if they were single words”. To
17 provide this missing feature of claim 7, the Action points on Stark’s
18 teaching that “the program lets me count the occurrence of odds, characters,
19 or phrases”. In reliance on this teaching of counting odds, characters, or
20 phrases, the Action concludes that it would have been obvious for a person
21 of ordinary skill in the art at the time of invention to have combined Stark
22 with Bornstein because “the program lets me count the occurrence of odds,
23 characters, or phrases” would give those skilled in the art tools to search
24 documents for single words and phrases. Both the assertion and the
25 corresponding conclusion are unsupportable.

1 It is respectfully submitted that counting the occurrence of odds,
2 characters, or phrases, even if it provided one skilled in the art a tool to
3 search documents for single words and phrases, does not teach or suggest
4 "ranking individual sentences in the document by treating the ordered sets
5 of words as if they were single words". Instead, counting the occurrence
6 of odds, characters, or phrases, as taught by Stark, results in counts, or
7 indication(s) of the number of odds, characters, or phrases in a document.
8 Combining Bornstein's sentence ranking with Starks odd, character, or
9 phrase counts likely results in sentence rankings based on odd, character, or
10 phrase counts. Clearly, nowhere does such a result teach or suggest
11 "ranking individual sentences in the document by *treating the ordered sets*
12 *of words as if they were single words*", as claim 7 recites [emphasis added].

13 For this additional reason, the 35 USC §103(a) rejection of claim 7
14 over Bornstein in view of Stark is improper and should be withdrawn.

15 Claims 8-12 depend from claim 7 and are allowable over Bornstein
16 in view of Stark solely by virtue of this dependency.

17 Accordingly, the 35 USC §103(a) rejection of claims 8-12 should be
18 withdrawn

19 **Conclusion**

20 Pending claims 1-18 are in condition for allowance, and action to
21 that end is respectfully requested. Should any issue remain that prevents
22 allowance of the application, the Office is encouraged to contact the
23 undersigned prior or issuance of a subsequent Office action.
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Respectfully submitted,

Dated: 02/22/2005

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